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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/028,867	12/21/2001	Chau U. Ko	AVERP2997USA	4665
7590 12/03/2003			EXAMINER	
William C. Tritt Renner, Otto, Boisselle & Sklar, LLP Nineteenth Floor 1621 Euclid Avenue Cleveland, OH 44115-2191			CHANG, VICTOR S	
			ART UNIT	PAPER NUMBER
			1771	
DATE MAILED: 12/03/2003				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/028,867	KO ET AL.	
	Examiner	Art Unit	
	Victor S Chang	1771	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 September 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
 4a) Of the above claim(s) 25-36 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
 * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
 a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>062003</u> | 6) <input type="checkbox"/> Other: |

DETAILED ACTION

1. The Examiner has carefully considered Applicant's amendments and remarks filed on 9/23/2003. Applicant's amendments to the specification and claim 1; and new claims 25-36 have all been entered.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. Rejections not maintained are withdrawn.

Election/Restrictions

4. Newly submitted claims 25-36 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

It is noted that newly submitted claims 25, 28 and 29 are directed to plasticizers which are liquid; claims 26, 27, 30, 31, 35 and 36 substantially recite the Markush group of plasticizers in claim 5, but is devoid of Kushida's nitrile rubber; and claims 32-34 requires a mixture of plasticizers. As such, newly added claims 25-36 are clearly directed to species which are distinct from the invention originally claimed.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 25-36 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Rejections - 35 USC § 112

5. Claims 1-24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With respect to Applicants' argument that "The term "a major amount" has been used extensively in patent claims. The term means that the material is present in an amount greater than 50%" (Remarks, page 10, second full paragraph), the Examiner notes that Applicants fail to provide any evidentiary support to show that "a major amount" means an amount greater than 50%. As such, the Examiner repeats (see Paper No. 5, page 2) that in claim 1, line 3, the phrase "a major amount" is vague and indefinite, i.e., it is not clear as to the scope of the limitation.

Response to Amendment

6. Claims 1-14 are rejected under 35 U.S.C. 102(b) as being anticipated by Kushida et al. (US 5344864), substantially for the reasons set forth in section 4 of Paper No. 5, together with the following additional observations.

It is noted that newly amended claim 1 now recites in part "a thickness from about 1 to about 20 mils".

With respect to Applicant's response arguing that "Kushida et al. do not teach or suggest preparing a vinyl halide film from their polyvinyl chloride elastomeric compositions" (Remarks, page 12, top paragraph), the Examiner repeats (see Paper

No. 5, page 3) that Kushida expressly teaches that when a plasticizer is incorporated, the vinyl chloride resin is used in many applications as resin material for various molded products such as films, sheets, etc. (column 1, lines 25-31), Applicants' argument to the contrary notwithstanding. As to the newly added thickness limitation, the Examiner notes that, in the absence of unexpected results, forming a film with a suitable thickness in the range of about 1-20 mils is believed to be well within the ordinary skill in the art of polymer films.

7. Claims 22-24 are rejected under 35 U.S.C. 102(a) as being anticipated by Breton et al. (US 6054524), substantially for the reasons set forth in section 5 of Paper No. 5, together with the following additional observations.

It is noted that newly amended claim 22 now recites in part "at least one aromatic solvent".

With respect to Applicants' argument that "Breton et al. do not teach the use of an aromatic solvent in plastisol compositions" (Remarks, page 14, third paragraph), the examiner notes that Breton does expressly teaches that for economic reasons, primary aromatic plasticizers (i.e., aromatic solvents) are normally preferred (column 2, lines 6-7), Applicants' argument to the contrary notwithstanding.

8. Claims 15-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kushida et al. (US 5344864) either individually, or in view of Hager et al. (US 5198301), substantially for the reasons set forth in section 7 of Paper No. 5, together with the following additional observations.

With respect to Applicants' argument that "The general statement does not provide motivation to use the Kushida et al. compositions to make film" (Remarks, page 15, first full paragraph), the Examiner repeats (see Paper No. 5, page 3) that Kushida expressly teaches that when a plasticizer is incorporated, the vinyl chloride resin is used in many applications as resin material for various molded products such as films, sheets, etc. (column 1, lines 25-31), as set forth above.

With respect to Applicants' argument that "Hager et al. relate to films which are made from ionomeric polyer resins with 2 to 40% by weight of filler" (Remarks, page 15, bottom paragraph), the Examiner repeats (see Paper No. 5, page 4) that Hager expressly teaches that it is known art that plasticized polyvinyl chloride film has been used in film form for numerous applications, such as adhesive tapes, etc. (column 1, lines 12-17), Applicants' argument to the contrary notwithstanding.

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor S Chang whose telephone number is 703-605-4296. The examiner can normally be reached on 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel H Morris can be reached on 703-308-2414. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9310.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

VSC

DANIEL ZIRKER
PRIMARY EXAMINER
GROUP 1366-
1700

